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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,077	09/30/2003	Mark S. Ortiz	END5100.0515145	9132
26874 7590 01/25/2008 FROST BROWN TODD, LLC 2200 PNC CENTER 201 E. FIFTH STREET CINCINNATI, OH 45202			EXAMINER RYCKMAN, MELISSA K	
			ART UNIT 3773	PAPER NUMBER
			NOTIFICATION DATE 01/25/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rgaunce@fbtlaw.com

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Office Action Summary

Application No.

10/675,077

Applicant(s)

ORTIZ, MARK S.

Examiner

Melissa Ryckman

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on claims received on 1/5/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-13,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/07 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 states a first control and a second control on the handle that are operatively configured to position at least one of the first, second and third members to separately actuate the plurality of distal arms. This is duplicated in the claim. The claim also states a first and third member operative to internally engage the proximal ring.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 recites the limitation "arresting member" in the second line of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim 17 is objected to as being dependent off of canceled claim 16.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,8,9,11-13,15,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Huebsch et al. (U.S. Patent No. 5,853,422).

Claim 1:

Huebsch teaches a system comprising: an applier and an anastomosis ring device having proximal (216), center (inward just to 242), and distal rings (214) connected respectively by proximal and distal hinged arms (225), the ring device having a generally cylindrical shape when unactuated (Fig. 23, generally cylindrical shape) and a rivet shape when actuated (Fig. 24), the applier comprising: an elongate implement portion (231); a handle connected to the implement portion (230); a first actuating member (238) internally engaged to the distal ring (214) of the anastomosis device; an

arresting member (232) internally engaged to the proximal ring (236) of the anastomosis device; a second actuating member (240) internally engaged to the center ring (inward jut of 242) of the anastomosis device; and a first control (inherently there is a first and second control on the handle to lock and unlock each of elements 242 and 238, as this is shown in a different embodiment, Fig. 11) coupled to the handle operably configured to cause movement of the first actuating member toward the arresting member; a second control (inherently there is a first and second control on the handle to lock and unlock each of elements 242 and 238, as this is shown in a different embodiment, Fig. 11) coupled to the handle operably configured to cause movement of the second actuating member toward the arresting member; wherein the first and second controls may be selectively positioned to reduce a first longitudinal separation (this is inherent when positioned in the way as described) between the center ring and a selected one of the proximal and distal rings causing actuating of the interposed hinged arms of the ring device while maintaining a second longitudinal separation between the center ring and the other ring preventing actuating of the interposed hinged arms of the ring device (this is inherent when positioned in the way as described); and wherein the first and second controls may be selectively positioned to reduce the longitudinal separation between the center ring and both the proximal ring and distal ring, causing actuating of all of the hinged arms of the ring (this is inherent when positioned in the way as described).

Claim 8:

Huebsch teaches the first actuating member (238) that is engaged to the distal ring (214) of the ring device distally terminates terminate in a catch (where 214 contacts 238 is a catch).

Claim 9:

Huebsch teaches the first actuating member (238) that is engaged to the distal ring (214) of the ring device includes a releasing surface (area contacting 214 and 238) responsive to an actuated condition of the ring device to disengage the first actuating member from the distal ring of the ring device.

Claim 11:

Huebsch teaches the implement portion is dimensionally sized for endoscopic surgical use (Fig. 5a).

Claim 12:

Huebsch teaches a system comprising: an applier and an anastomotic ring (Fig. 16) device having a center circular portion (center portion Fig. 16) longitudinally connected by a plurality of proximal arms (225) to a proximal ring (214) and by a plurality of distal arms (200) to a distal ring (216), the ring expanding each plurality of arms by compressing a respective ring toward the center circular portion (Fig. 16), the applier comprising: a first member (distal portion of 238) operative to internally engage the proximal ring (214); a second member (242) operative to internally engage the center circular portion; a third member (proximal portion of 238) operative to internally engage the proximal ring (214); and a handle (230); a first control (inherently there is a first and second control on the handle to lock and unlock each of elements 242 and 238,

as this is shown in a different embodiment, Fig. 11) on the handle operatively configured to position at least one of the first, second and third members to separately actuate the plurality of distal arms; and a second control (inherently there is a first and second control on the handle to lock and unlock each of elements 242 and 238, as this is shown in a different embodiment, Fig. 11) on the handle operatively configured to position at least one of the first, second and third members to separately actuate the plurality of distal arms.

Claim 13:

Huebsch teaches the center circular portion of the ring device comprises a center ring (inner jut of 242, Fig. 16) the second member (242) engaged to the center ring (inner jut of 242, Fig. 16).

Claim 15:

Huebsch teaches the first (distal portion of 238) and third members (proximal portion of 238) comprise a releasable engagement mechanism responsive to an actuated condition of the anastomotic device (lock, col. 7, ll. 7).

Claim 17:

Huebsch teaches a cannula (231, col. 6, ll. 41) distally supporting the first and second members and arresting member and proximally attached to the handle, operatively configured to distally receive the anastomotic device, dimensioned for endoscopic use (Fig. 16).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huebsch in view of Adams (US 6632227). Huebsch teaches all elements of preceding dependent claims 1, 8 and 9 as previously described, wherein the applier includes a distal tip illuminator connected to the implement portion. Adams teaches an endoscopic device wherein the distal end comprises a light at the distal end in order to make visual observations of the desired site. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Huebsch with a light at the distal end as taught by Adams in order to make visual observations of the desired site.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Ryckman whose telephone number is (571)-272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR


(JACKIE) TAN-UYEN HO
SUPERVISORY PATENT EXAMINER